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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,542	08/03/2000	Ryoichi Imanaka	MAT-3720US3	9883

7590
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Valley Forge, PA 19482

EXAMINER

PARRY, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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2421

MAIL DATE	DELIVERY MODE
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03/10/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/631,542	Applicant(s) IMANAKA, RYOICHI	
	Examiner CHRIS PARRY	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 December 2009 has been entered.

Reissue Applications

2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,790,172 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Response to Arguments

3. Applicant's arguments with respect to claims 17 and 18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durden et al. "Durden" (USPN 5,003,384) in view of Horton et al. "Horton" (USPN 4,945,563).

Regarding Claim 17, Durden discloses a server apparatus (5-10, 18 and 19 – fig. 1) comprising:

an information provider (18 – fig. 1) which receives an information signal (i.e., "Pre-Buy" request or "Buy" request) from a subscriber apparatus (15 – fig. 1), the information signal a) capable of indicating that a program having a title outputted from said server apparatus is provided to a display terminal in said subscriber apparatus without being recorded (i.e., a "Buy" request indicates the user would like to view the PPV event without recording) and b) capable of indicating that said program having said title outputted from said server apparatus is recorded in said subscriber apparatus (i.e.,

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a “Pre-Buy” request indicates the user would like to record the PPV event) (fig. 3; Col. 11, line 57 to Col. 12, line 14 and Col. 12, lines 24-32 and 44-66)

a subscriber mode recognizer (8 – fig. 1) which discriminates between said program having said title being provided to the display terminal without being recorded and being provided to the recorder based on the information signal (i.e., set-top terminal 15 provides event records to system manager 8, where system manager 8 determines whether the request is a “Pre-Buy” or a “Buy” in order to determine whether to charge the user now or later) (Col. 6, line 43 to Col. 7, line 4 and Col. 12, lines 24-63); and

a charger (5 – fig. 1) which charges a) in the case that said program having said title is provided to said display terminal without being recorded and b) in the case that said program having said title is provided to said recorder, based on the recognition of said subscriber mode recognizer (Col. 4, line 45 to Col. 5, line 11).

Durden fails to specifically disclose a charger which charges a different amount among a) in the case that said program having said title is provided to said display terminal without being recorded and b) in the case that said program having said title is provided to said recorder, based on the recognition of said subscriber mode recognizer.

In an analogous art, Horton discloses a charger which charges a different amount among a) in the case that said program having said title is provided to said display terminal without being recorded (i.e., viewer has selected to view the program and pay a first fee; Col. 2, lines 59-61 & Col. 3, lines 43-47) and b) in the case that said program having said title is provided to said recorder, based on the recognition of said subscriber mode recognizer (i.e., a viewer may request a program, such as a first run

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movie, and depending upon a selected viewing mode, the selected program may be viewed and the viewer would pay a first fee or the viewer could choose to view and record the program for a second higher fee or "different amount", wherein the cable TV distribution system can pre-authorize the receiver 20 to receive the program and also indicate the mode of reception) (Col. 2, lines 56-65 and Col. 3, lines 39-53 and lines 61-67). Horton teaches it is well known in the art for a cable or satellite provider to charge viewers different amounts depending upon whether the viewer has selected to merely view the program or has selected to create a copy of the program by recording it for later or repeated viewing (Col. 3, lines 61-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Durden to include a charger which charges a different amount among a) in the case that said program having said title is provided to said display terminal without being recorded and b) in the case that said program having said title is provided to said recorder, based on the recognition of said subscriber mode recognizer as taught by Horton for the benefit of combining prior art elements according to known methods to yield predictable results of charging a second higher fee that includes a charge related to the purchase of a cassette of the program while preventing the viewer from making pirated copies of the recorded program (Horton: Col. 2, line 63 to Col. 3, line 3).

As for Claim 18, Durden and Horton disclose, in particular Horton teaches wherein said charger charges a larger amount when the output signal is provided to said recorder than to said display terminal without being recorded (i.e., a viewer may

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request a program, such as a first run movie, and depending upon a selected viewing mode, the selected program may be viewed and the viewer would pay a first fee or the viewer could choose to view and record the program for a second higher fee or "larger amount") (Col. 2, lines 56-65).

As for Claim 19, Durden and Horton disclose, in particular Horton teaches wherein said program is other than a shortened version of said program which is sent to the display terminal for a lower charged amount than said program being sent to the display terminal without being shortened (i.e., depending upon a selected viewing mode, the selected program may be viewed and the viewer would pay a first lower fee or the viewer could choose to view and record the program for a second higher fee) (Col. 2, lines 56-65 and Col. 3, lines 39-53).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS PARRY whose telephone number is (571) 272-8328. The examiner can normally be reached on Monday through Friday, 8:00 AM EST to 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN MILLER can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

CHRIS PARRY
Examiner
Art Unit 2421

/C. P./
Examiner, Art Unit 2421